

Appl. No. 09/869,630
Amdt. Dated June 2, 2004
Reply to Office action of December 2, 2003

REMARKS

Claims 1-9 are pending in the instant application. Claims 1-9 stand rejected under 35 U.S.C. §112, second paragraph for failing to particularly point out and distinctly claim the subject matter which the applicants regards as the invention. Claim 1 stands rejected under 35 U.S.C. §102(b) as being anticipated by WO 95/27438 of Balamore. Claims 1,2, and 5-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 6,090,800 to Unger in view of United States Patent No. 6,511,967 to Weissleder et al. The claims have been amended. Claim 1 has been amended to incorporate the limitations of claim 2, which has been cancelled. Claims 3 and 4 have been amended to depend from claim 1. None of the amendments constitute new matter in contravention of 35 U.S.C. §132. Reconsideration is respectfully requested.

First, Applicants gratefully acknowledge the indicated allowability of claims 3 and 4.

Claims 1-9 stand rejected under 35 U.S.C. §112, second paragraph for failing to particularly point out and distinctly claim the subject matter which the applicants regards as the invention. This rejection is respectfully traversed.

The examiner rejects claim 1 as having insufficient antecedent basis for the term “the environment”. Applicants submit that the Examiner is only specifying a fraction of the full term which is properly stated as “the environment of the biological molecule”. As so stated, Applicants respectfully submit that the term is properly recited and does not require an introductory indefinite article. Reconsideration and withdrawal of the rejection are respectfully requested.

The examiner rejects claim 2 for not reciting the steps involved in the respective assay methods. Applicants respectfully submit that no amendment is required as the claim is intended to cover all assays. The Examiner’s requirement that assay steps must be recite is

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not supported. Therefore, the claim points out and distinctly claims Applicants' invention. Reconsideration and withdrawal of the rejection are respectfully requested.

The Examiner rejects claim 3 for reciting a competition assay, but does not claim a competing reagent or competing analyte and does not claim with what it is competing. Applicants respectfully submit that such limitations are unnecessary because the terms are believed to be fully claimed. The term "competition assay" is a term of art that would be clearly understood by the skilled reader. The claim is intended to cover any such assays, and reciting specific steps for these assays would unnecessarily restrict the scope of the claims. Reconsideration and withdrawal of the rejection are respectfully requested.

The Examiner rejects claim 4 for not claiming whether a nucleic acid is required. Applicants respectfully submit that the term "hybridisation assay" is a term of art that would be clearly understood by the skilled reader. The claim is intended to cover any such assays, and reciting such suggested limitations for these assays would unnecessarily restrict the scope of the claims. Reconsideration and withdrawal of the rejection are respectfully requested.

Claim 1 stands rejected under 35 U.S.C. §102(b) as being anticipated by WO 95/27438 of Balamore. This rejection is respectfully traversed.

Balamore discloses a method of imaging a noble gas in *in vitro* chemical, *in vitro* biological and *in vivo* biological systems (page 7 lines 20-22). Also, on page 8 lines 22-23 it is stated that the noble gas may be contacted with the sample to be imaged. This arguably constitutes labelling a biological molecule with the noble gas. ¹²⁹Xe is disclosed as a noble gas that can be used in the methods of the invention (e.g. page 6 lines 17-20). However, there is nothing in Balamore to suggest that the biological molecule is an assay reagent taking part in an assay method as currently claimed in claim 1. Therefore, as Balamore fails to disclose each and every element of claim 1, Applicants respectfully submit that claim 1 is novel thereover. Reconsideration and withdrawal of the rejection are respectfully requested.

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Claims 1,2, and 5-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 6,090,800 to Unger in view of United States Patent No. 6,511,967 to Weissleder et al. This rejection is respectfully traversed.

Applicants respectfully submit, as the Examiner admits, that Unger fails to disclose, that ¹²⁹Xe can be used in an *in vitro* method. Wherever ¹²⁹Xe is mentioned in Unger it is specifically in relation to *in vivo* imaging, e.g. the section of the description headed “Contrast Agents” from column 55 line 34 to column 60 line 21. None of the *in vitro* applications referred to by Unger and cited by the examiner comprise the use of ¹²⁹Xe nor does Unger suggest the use of ¹²⁹Xe for *in vitro* applications.

Moreover, Applicants respectfully submit that the priority date of Weissleder is 23 April 1999, whereas the priority date of the present application is 30 December 1998 (to GB patent application no. 9828853.3). Therefore Weissleder is not valid prior art for evaluation of the present application and the deficiencies of Unger remain uncorrected.

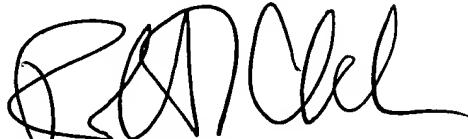
Therefore, as Unger fails to disclose, teach, or suggest the present invention, Applicants submit that the present invention is patentably distinct thereover. Reconsideration and withdrawal of the rejection are respectfully requested.

In view of the amendments and remarks hereinabove, Applicants respectfully submit that the instant application, including claims 1 and 3-9, is in condition for allowance. Favorable action thereon is respectfully requested.

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Any questions with respect to the foregoing may be directed to Applicants' undersigned counsel at the telephone number below.

Respectfully submitted,



Robert F. Chisholm
Reg. No. 39,939

Amersham Health, Inc.
101 Carnegie Center
Princeton, NJ 08540
Phone (609) 514-6905